

A. KINGSMAN et al.
Application No.: 10/016,686
Page 4

PATENT

REMARKS

Claim 60 has been revised in light of the telephonic interview on December 15, 2004 as discussed below. Part "a)" of the claim has been revised to make explicit the implicit content of that portion of the claim. Specifically, claim 60 has been revised based on page 21, lines 5-30 of the instant application. Lines 5-13 therein support "selectively hybridizing" while lines 28-30 therein support "stringent conditions of 65°C and 0.1x SSC (wherein 1x SSC is 0.15 M NaCl, 0.015 M Na₃Citrate, pH 7.0)".

With respect to the recitation of "selectively hybridizing", lines 5-13 on page 21 explicitly defines the term as meaning that hybridization between a nucleotide sequence of the invention (e.g. the isolated sequence of claim 60, part "a)") and another nucleotide sequence (e.g. the sequence of claim 54) occurs "at a level significantly above background" hybridization to other nucleotide sequences that may be present. Thus part "a)" of claim 60 remains directed to an "isolated nucleotide sequence" capable of hybridizing to the sequence of claim 54 under the conditions specified in part "a)". The "isolated nucleotide sequence" of claim 60 cannot encompass, for example, a heterogeneous population of random primers which might include one primer that hybridizes to the sequence of claim 54 under the specified conditions because that one possible primer, if it exists, would also hybridize under those conditions to other primers in the population as part of the background level of hybridization. Thus that one possible primer in a heterogeneous population of random primers would not be "capable of selectively hybridizing" to the sequence of claim 54 as encompassed by claim 60.

The revision to part "b)" of the claim restores that portion to be analogous to that of claim 60 as originally filed by deletion of the "wherein" clause.

Neither part of claim 60 is believed to have been narrowed.

Based on helpful comments from the Examiner, claim 66 has been revised to improve its correspondence to claim 54, from which claim 66 depends, and to remove extraneous language describing inherent features of the claimed invention.

No new matter has been introduced by the above revised claims and entry thereof is respectfully requested.

A. KINGSMAN et al.
Application No.: 10/016,686
Page 5

PATENT

Interview of December 15, 2004

Applicants thank Examiner Helms for the courtesy of a telephonic discussion on December 15, 2004. The scopes of claims 54 and 60 were discussed, and Examiner Helms indicated that revised claim 60 submitted on November 29, 2004 raised additional issues for consideration but that an expression of specific hybridization conditions would be likely sufficient to render the claim allowable. Possible alternative language for parts "a)" and "b)" of the claim was discussed. Examiner Helms indicated that the deletion of the "wherein" clause in part "b)" would be acceptable to resolve issues with respect to that part of the claim.

Examiner Helms also pointed out the need to make claim 66 consistent with the language of claim 54 from which claim 66 depends. Applicants thank the Examiner for his helpful comments and suggestions.

Acknowledgements

Applicants thank the Examiner for the indication of the correction of inventorship and the spelling of the last name of co-inventor Carroll.

Applicants also thank the Examiner for the indication that claims 52-54, 57, 61, 63, 65, 66, and 68 are allowable.

Claim Rejections under 35 USC § 112, second paragraph

Claim 60 and claims dependent therefrom were rejected under 35 USC § 112, second paragraph as allegedly indefinite for reciting "stringent conditions". Applicants have revised the claim as presented above to use alternative language as literally supported on page 21, lines 5-30, in relation to the hybridization conditions. The new language is believed to be clear and definite to the artisan in light of the specification, and withdrawal of this rejection is respectfully requested.

Claim Rejections under 35 USC § 112, first paragraph

Claim 60 and claims dependent therefrom were rejected under 35 USC § 112, first paragraph as allegedly non-enabling because "[i]t is not possible for the nucleic acid that

A. KINGSMAN et al.
Application No.: 10/016,686
Page 6

PATENT

hybridizes to SEQ ID NO:5 coding strand to encode a ScFv that binds 5T4 antigen. It is also known that one could not produce a ScFv with just any DNA that hybridizes to or is complementary to the DNA of SEQ ID NO:5."

Applicants have carefully reviewed the statement of the instant rejection and respectfully traverse because no *prima facie* case of undue experimentation has been presented.

As previously explained in the Response filed November 29, 2004, the last "wherein" clause in claim 60 only applied to part "b)" of the claim such that there was no issue with respect to a sequence which hybridizes to SEQ ID NO:5 as encoding a ScFv that binds 5T4 antigen.


Based on the interview of December 15, 2004, however, Applicants are of the understanding that deletion of the "wherein" clause resolves all issues with respect to part "b)" of the claim and so this rejection may be properly withdrawn.

Conclusion

In light of the above amendments and arguments, Applicants respectfully submit that the claims are in condition for allowance and respectfully urge passage of the instant application to issue.

If the Examiner believes a telephonic discussion would expedite prosecution of this application, he is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,


Kawai Lau, Ph.D.
Reg. No. 44,461

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834
Tel: (858) 350-6151
Fax: (415) 576-0300

60378987 v1